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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,231	01/02/2002	Edith H. Stern	YOR920010483US1	2900
48175	7590	10/31/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			NGUYEN, PHUNG	
			ART UNIT	PAPER NUMBER
			2632	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,231

Applicant(s)

STERN ET AL.

Examiner

Phung T. Nguyen

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 42-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37, 42-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

**Note:** This Office Action is in response to the amendment dated 07/22/04.

Claims 2, 4, 7, 9-10, 13-16, 19, 22, 25, 27-28, 31, 33, 34, 46 and 49-50 have been amended.

Claims 38-41 have been canceled.

Claim 52 has been added.

As a result, claims 1-37 and 42-52 will remain pending in the application.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 7-10, 14, 15, 17, 19-23, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle (U.S. Pat. 5,831,531).

**Regarding claim 1:** Tuttle discloses an anti-theft method for detecting the unauthorized opening of container and baggage which comprises receiving an indication that the container has been opened (col. 1, lines 49-57). Tuttle fails to teach arranging for ownership of the items to be transferred based on the indication. Official Notice is taken that the concept of arranging for ownership of the item to be transferred based on the indication is well known and expected in the art. It would have been obvious to arrange for ownership of the item to be transferred to the customer when the customer opens the package in order to provide payment for a limited amount of the consumable item which is convenient.

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**Regarding claim 2:** Tuttle discloses wherein ownership is transferred to at least one of: a person who opened the container, or a party associated with the container (col. 4, lines 40-45).

**Regarding claim 5:** Tuttle discloses receiving a signal generated by a remote transmitting device (col. 1, lines 54-57).

**Regarding claim 7:** Tuttle discloses wherein the transmitting device is associated with at least one of: radio transmitter, a photosensitive device, a pressure sensitive device, a conductive element attached to an enclosure, a seal having a conductive element, a seal having a non-conductive element, and a flexible printed circuit board device (col. 5, lines 10-17).

**Regarding claim 8:** Tuttle discloses receiving the signal at a controller via a communication device (col. 4, lines 15-21).

**Regarding claim 9:** Tuttle discloses the indication including at least one of: a party identifier, an item identifier, an item category, a container identifier, a date, a time, and location information (col. 4, lines 32-38).

**Regarding claim 10:** Tuttle discloses the indication is received via at least one of: a wireless network, an Internet protocol, a Bluetooth network, or a cellular network (col. 1, lines 54-57).

**Regarding claim 14:** Tuttle discloses wherein the item comprises at least one of: a consumer item, a consumable item, paper, toner, energy, food, a medical item, medicine, disposable contact lenses, a software program, an entertainment item, text information, audio information, image information, an information storage item, a regular item, or a financial item (col. 5, lines 40-44).

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**Regarding claim 15:** Tuttle discloses wherein the container comprises at least one of: a package, a wrapper, a box, a bag, a bottle, a can, an envelope, a label, a tag, or a tie (figure 6, col. 4, lines 32-34).

**Regarding claim 17:** All the claimed subject matter is already discussed in respect to claim 1 above. Tuttle also discloses a processor and storage device in communication with the processor and storing instructions adapted to be executed by the processor (col. 4, lines 15-18).

**Regarding claim 19:** Tuttle discloses a communication device coupled to the processor and adapted to communicate with at least one of: a container, a local device, a controller, or a payment device (col. 4, lines 12-15).

**Regarding claim 20:** All the claimed subject matter is already discussed in respect to claim 1 above.

**Regarding claim 21:** All the claimed subject matter is already discussed in respect to claim 1 above. Tuttle also discloses another item to be provided based on the indication (col. 4, lines 18-21).

**Regarding claim 22:** Refer to claim 2 above.

**Regarding claim 23:** Tuttle discloses a plurality of containers and arranging is performed after a pre-determined number of indications are received (col. 4, lines 18-25).

**Regarding claim 52:** All the claimed subject matter is already discussed in respect to claim 1 above.

3. Claims 3, 4, 11, 12, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle in view of Blomqvist et al. (U.S. Pat. 5,859,415).

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**Regarding claim 3:** Tuttle does not teach arranging for a party to provide payment in exchange for the item based on the indication as claimed. However, Blomqvist et al. teach arranging for a party to provide payment through wireless transmission of radiowaves in exchange for the item based on the indication (col. 2, lines 45-53, and col. 6, lines 15-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Blomqvist et al. in the system of Tuttle because it would be more convenient to make a payment through wireless transmission of radiowaves.

**Regarding claim 4:** Blomqvist et al. teach wherein the payment is associated with at least one of: a purchase, a license, a loan, or a rental (col. 3, lines 22-25).

**Regarding claim 11:** Tuttle does not providing the container to a party without receiving payment in exchange for the item. Blomqvist et al. teach the use of debit card (col. 4, lines 22-23). In view of the teachings by Tuttle and Blomqvist et al., it would be obvious to the skilled artisan to utilize the debit card such as taught by Blomqvist et al. in the system of Tuttle in order to extend the use of the device.

**Regarding claim 12:** Blomqvist et al. teach arranging for the party to provide security deposit information (col. 3, lines 61-67).

**Regarding claim 13:** Blomqvist et al. teach wherein the security deposit information comprises at least one of: a credit card number, a debit card number, a bank account number, digital payment protocol information, or an address (col. 4, lines 1-4).

**Regarding claim 16:** All the claimed subject matter is already discussed in respect to claims 1 and 11 above.

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4. Claims 6, and 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle in view of Romano et al. (U.S. Pat. 6,507,275).

**Regarding claim 6:** Tuttle does not teach wherein the transmitting device does not transmit a signal when the container is subsequently re-opened. However, Romano et al. teach pill dispensing reminder system for indicating when to take a specific pill which comprises the transmitting device does not transmit a signal when the container is subsequently re-opened (col. 4, lines 18-37). Therefore, it would have been obvious to the skilled artisan to utilize the teaching of Romano et al. in the system of Tuttle so that once the container is re-opened, the transmitting device does not need to transmit a signal again which is an advantage by saving power.

**Regarding claim 44:** All the claimed subject matter is already discussed in respect to claims 1 and 6 above. Romano et al. also disclose verifying that the container was opened in accordance with an item requirement (col. 3, lines 56-67).

**Regarding claim 45:** Romano et al. teach transmitting an alert if the container was not opened in accordance with the item requirement (col. 3, lines 57-59).

**Regarding claim 46:** Romano et al. teach wherein the alert is transmitted to at least one of: a person who opened the container, a party associated with the item, or a third party (col. 4, lines 35-37).

**Regarding claim 47:** Romano et al. teach the item is associated with a medical treatment program (col. 3, lines 27-30).

**Regarding claim 48:** All the claimed subject matter is already discussed in respect to claims 1 and 6 above.

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**Regarding claim 49:** Romano et al. teach the enclosure comprising at least one of: a package, a wrapper, a box, a bag, a bottle, a can, an envelope, a label, a tag, or a tie (col. 3, lines 27-30).

**Regarding claim 50:** Tuttle discloses wherein the transmitting device is associated with at least one of: radio transmitter, a photosensitive device, a pressure sensitive device, a conductive element attached to an enclosure, a seal having a conductive element, a seal having a non-conductive element, or a flexible printed circuit board device (col. 5, lines 10-17).

**Regarding claim 51:** Tuttle discloses the transmitting device does not transmit the signal if a predetermined number of other containers are present (col. 1, lines 54-57). It is seen that the transmitting device transmits the signal only if continuity is disable.

5. Claims 18, and 24-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle in view of Reber et al. (U.S. Pat. 5,798,694).

**Regarding claim 18:** Tuttle discloses the Host/CPU 51 as the storage device as seen in figure 5, col. 4, lines 12-16 but does not show the storage device further stores a container status database as claimed. However, Reber et al. teach food storage apparatus and method and systems for monitoring a food item comprising a container status database (col. 5, lines 40-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tuttle and Reber et al. in order to keep track with the status of the container.

**Regarding claim 24:** Tuttle does not disclose determining a rate of usage based on the indication. However, determining a rate of usage based on the indication is old and known in the



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art as taught by Reber et al. (col. 5, lines 19-27). Therefore, it would be obvious to the skilled artisan to use the technique of Reber et al. in the system of Tuttle in order to monitor the item.

**Regarding claim 25:** Reber et al. teach wherein the rate of usage is associated with at least one of: a party associated with the container, an owner of the container, a person who opened the container, or a destination associated with the container (col. 2, lines 14-18).

**Regarding claim 26:** Reber et al. disclose reporting the rate of usage to a party associated with the container (col. 5, lines 19-27).

**Regarding claim 27:** Reber et al. disclose wherein the reporting is performed at least one of: periodically, single time, when the rate of usage is less than a minimum predetermined threshold amount, or when the rate of usage is more than a predetermined maximum threshold amount (col. 5, lines 28-58).

**Regarding claim 28:** Reber et al. teach wherein the indication comprises at least one of: an indication of a number of container that have been opened, or an indication of a number of container remaining (col. 5, lines 19-27).

**Regarding claim 29:** Tuttle disclose monitoring a remote container associated with an item which comprises receiving an indication that the container has been opened (col. 1, lines 54-57, and col. 4, lines 32-61) but does not disclose determining item quality information based on the indication. However, Reber et al. teach determining item quality information based on the indication (col. 5, lines 40-49). Therefore, it would have been obvious to the skilled artisan to use the teaching of Reber et al. in the system of Tuttle for monitoring the condition of the item which is an advantage.

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**Regarding claim 30:** Reber et al. teach wherein the determining is based on the date the indication was received (col. 5, lines 40-49).

**Regarding claim 31:** Reber et al. teach wherein the determining is further based on a date associated with at least one of: creation of the item, packaging of the item, sale of the item, or delivery of the item (col. 4, lines 14-19).

**Regarding claim 32:** Reber et al. disclose transmitting an indication of the item quality information (col. 3, lines 24-29).

**Regarding claim 33:** Reber et al. teach wherein the indication of the item quality information is transmitted to the owner of the container, which is met by providing a visual indication of a condition of the item (col. 4, lines 5-8).

**Regarding claim 34:** Reber et al. teach the indication is transmitted at least one of: periodically, a single time, or when the item quality information is less than a pre-determined minimum item quality (col. 4, lines 42-54).

**Regarding claim 35:** All the claimed subject matter is already discussed in respect to claim 29 above. Reber et al. also disclose determining item warranty information based on the indication (col. 5, lines 33-38).

**Regarding claim 36:** Refer to claim 30 above.

**Regarding claim 37:** The claimed limitation has been addressed in respect to claim 35 above. It is inherently seen that the warranty information is associated with a return policy.

6. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle in view of Tsou et al. (U.S. Pat. 6,578,199).

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**Regarding claim 42:** Tuttle discloses an anti-theft method for detecting the unauthorized opening of container and baggage which comprises receiving an indication that the container has been opened (col. 1, lines 49-57) but does not disclose recording the indication as an acceptance of an agreement associated with the item. However, recording the indication as an acceptance of an agreement associated with the item is known in the art as taught by Tsou et al. (col. 9, lines 24-38). Therefore, it would have been obvious to the skilled artisan to employ the teaching of Tsou et al. in the system of Tuttle for monitoring the item.

**Regarding claim 43:** Tsou et al. disclose the item is associated with a software program and the agreement comprising a license to use the software program (col. 3, lines 16-31).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung T Nguyen whose telephone number is 571-272-2968. The examiner can normally be reached on 8:00am-5:30pm Mon thru. Friday, with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on 571-272-2964. The fax numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-308-9051 for After Final communications.

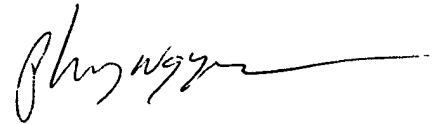
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

Phung Nguyen

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A handwritten signature in black ink, appearing to read "Phy W. G. Y.", with a long horizontal flourish extending to the right.

Date: October 28, 2005